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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Fumio KOYAMA et al.

Group Art Unit: 2828

Application No.: 10/026,637

Examiner: James W. Davie

Filed: December 27, 2001

Docket No.: 111587

For: SURFACE EMITTING SEMICONDUCTOR LASER AND MANUFACTURING  
METHOD THEREOF

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Sir:

In reply to the October 8, 2003 Office Action, reconsideration of the rejections is respectfully requested in light of the following remarks. Claims 1-26 remain pending.

The Office Action rejects claims 1-10 and 16-23 under 35 U.S.C. §112, second paragraph. Although the Office Action does not specifically reject claims 13-15, Applicants assume that this rejection is intended to apply also to claims 13-15 since they depend from independent claim 1 and thus inherit the alleged defect of claim 1. Accordingly, Applicants will discuss this rejection as if applied to claims 1-10 and 13-23. Applicants respectfully traverse this rejection.

In particular, Applicants request further clarification on the Patent Office's assertion that the claims are indefinite. While the Office Action asserts these claims contain indefinite subject matter, the Office Action is completely silent as to what is indefinite about these claims such that one of ordinary skill in the art would not be able to discern the metes and

bounds of the claims or determine if the claims are infringed. For instance, the claims may be indefinite because of inconsistency between the claims and the specification, or the claims may be indefinite because the meaning of every term is not apparent, or for some other reason. Without some analysis, the Applicants cannot judge the sufficiency of the rejection nor determine how to respond to the rejection. Nor does the Office Action, in failing to provide such analysis, comply with the standards of substantive due process required in Office Actions under *In re Zurko* and the Administrative Procedures Act.

In other words, the Patent Office has not established a *prima facie* case of indefiniteness and has not established why a person of ordinary skill in the art would not be able to understand the meaning of the cited features. Applicants respectfully remind the Patent Office that the burden of establishing a *prima facie* case of indefiniteness is on the Patent Office.

Moreover, Applicants assert that "a boundary region" is clearly defined in the specification in, for instance, page 8, lines 1-12 and page 23, line 26 - page 25, line 6. Applicants further assert that the boundary region is defined in the specification as including being formed of holes (page 24, lines 10, 18, 26; page 25, lines 7-8 and 15-16) or being formed of grooves (page 24, lines 14, 21-22; page 25, lines 2-3, 10-11 and 19). The boundary region, whether in the form of holes or grooves, is also shown in Fig. 1 of Applicants' specification. The specification, at the pages referenced above, clearly defines the boundary region for each one of the applicable modes (LP<sub>xy</sub>, where xy correspond to the order of the mode LP). Additionally, as further explained on page 8, lines 8-10, the boundary region suppresses the light emission of oscillation modes except for the specific oscillation mode to which the boundary region corresponds. As such, Applicants assert that the boundary region, as recited in claim 1, is sufficiently defined in the specification. Accordingly, Applicants

respectfully request that the rejection of claim 1 under 35 U.S.C. §112, second paragraph, be withdrawn.

Moreover, Applicants assert that the divided regions are sufficiently defined in the specification at, for instance, page 8, lines 1-12 and page 25, lines 23-26. The divided regions, as defined in the specification, are defined as the regions in which "the boundary regions of the present invention and the light emitting spots obtained are formed in the regions divided by the respective holes and grooves." (Page 25, lines 23-26). Thus, for example, the "regions divided by the respective holes and grooves" correspond to "the divided regions" recited in claims 1 and 16. Accordingly, Applicants assert that the features of claims 1 and 16 are sufficiently defined in the specification. As such, Applicants respectfully request that the rejection of claims 1 and 16, and their dependent claims, under 35 U.S.C. §112, second paragraph, be withdrawn.

Regarding the Restriction Requirement, Applicants assert that the finality of the Restriction is improper. The grounds for the Restriction Requirement, in the latest Office Action, are different from the grounds of Restriction set forth in the June 23, 2003 Office Action. The June 23 Office Action alleges that the process in claims 11 and 12 can be used to make another and materially different product, while the latest Office Action alleges that the method in claims 11 and 12 requires a step that is not required in the device claims. Accordingly, since the latest Restriction Requirement is based on new grounds, the latest Restriction Requirement should not have been made final.

Additionally, the Patent Office alleges that the step of forming a post position, as recited in claim 11, is not required in the device claims, but does not provide any explanation as to why it would be the case. Since the burden of establishing why the step of claim 11 is not required in the device claims is on the Patent Office, Applicants respectfully request clarification.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-26 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:TMN/cmf

Date: January 8, 2004

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